

Atty Dkt. No.: SIER-022CON
USSN: 10/826,466

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REMARKS

Formal Matters

Claim 46 has been amended to specify that: 1) the coding sequence in the first and second expression systems are the same as well as to clarify certain claim terms, and 2) to include a step for determining whether transcription is altered from the second expression system in response to contacting to the agent of interest.

Claims 48, 55, 56 and 59 have been amended to be consistent with the amendments to Claim 46.

As no new matter is added by way of these amendments, entry thereof by the Examiner is respectfully requested.

Double Patenting

The Examiner has made note that the Terminal Disclaimer filed in response to the Final Office Action has overcome the Double Patenting rejection.

Claim Rejections – 35 USC § 112

The Examiner has rejected of Claims 46, 48, 49 and 53 – 61 under 35 USC § 112, first paragraph for failing to comply with the enablement requirement.

In making this rejection, the Examiner asserts that the specification does not enable the claimed invention because it does not provide a description of how one of skill in the art can employ two different coding sequences in the first (test) and second (control) expression systems when practicing the claimed invention.

Solely to expedite prosecution of the subject application, the Applicants have amended Claim 46 (the only independent claim) to specify that the two expression systems contain the same coding sequence, which the Examiner noted was enabled by the specification (see page 6, lines 14-16, of the current Office Action).

The Applicants herein reserve the right to pursue claims in one or more

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continuing applications in which the first and second expression systems contain different coding sequences.

In view of these amendments, the Applicants submit that the claims are fully enabled by the specification, and as such respectfully request withdrawal of this rejection.

The Examiner has rejected of Claims 46, 48, 49 and 53 – 61 under 35 USC § 112, second paragraph as being incomplete for omitting essential steps.

In making this rejection, the Examiner asserts that the claimed invention has omitted the step of determining whether transcription of the coding sequence in the second expression system is "repressed" in the presence of the agent.

In response, the Applicants have amended Claim 46 to include the step of determining whether transcription of the coding sequence of the second expression system is altered in response to the agent. Because transcription of the coding sequence in the second expression system will not be "repressed" due to the presence of the GC-Box 5 site (as is the coding sequence in the first expression system), one determines whether transcription of the coding sequence in the second expression system is altered (either positively or negatively), where an alteration indicates that the agent is having an affect that is independent of the GC-Box 5 site(s).

In view of these amendments, the Applicants submit that the claimed invention is complete, and as such respectfully request withdrawal of this rejection.

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CONCLUSION

In view of the amendments and remarks above, the Applicants respectfully submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone Bret Field at (650) 833-7770.

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16 and 1.17 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 50-0815, order number SIER-022CON.

Respectfully submitted,
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